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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,751	06/22/2001	Steven S. Kantner	55980USA1B.004	7737

7590 06/03/2002

Attention: Robert W. Sprague
Office of Intellectual Property Counsel
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St. Paul, MN 55133-3427

EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 06/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant(s)	Applicant(s)	
	09/887,751	KANTNER ET AL.	
	Examiner	Art-Unit	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-16 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Amendment filed on February 19, 2002. Claims 1-16 are pending. Examiner notes that claim 16 was inadvertently left out from the rejection statement in the office action dated November 20, 2001. However, since the accompanied office action summary indicated the rejection of the all pending claims, and the explanation for rejection of claim 16 under 35 U.S.C. § 102 in view of Bolich (US 5662892) was provided, it is viewed proper that the rejection of claim 16 is reinstated in this office action and now rejected under a new rejection. See previous office action dated November 20, 2001, page 3, lines 19-21.

The claim rejection under 35 U.S.C. 102 in view of Mougin is withdrawn in view of applicants' remarks. New rejections are made in view of claim amendments made by applicants.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-8 and 10-16 are rejected as being unpatentable over Bolich, Jr et al. (US 5662892) ("Bolich").

Bolich teaches hair styling/conditioning compositions containing the copolymers of C1-C18 alkyl esters of acrylic or methacrylic acid in aqueous carrier. See abstract. The monomers of instant claim 1(a)(i) such as n-butyl (meth)acrylate in the amount of

10-95 wt %; and the monomers of instant claim 1(a)(ii) such as dimethyladamentyl (meth)acrylate or isobornyl (meth)acrylate are used in the amount of 10-50 wt %, meeting instant claims . See col. 4, line 47 – col. 5, line 30. The additives of instant claim 12, including thickeners, surfactants and silicone and oil conditioning agents, are disclosed in col. 7, line 55 - col. 21, line 56. Instant claim 11 is met by the disclosure that the linear copolymers form a film having a Tg of at least about 30 degree Celcius so that they are not unduly sticky or tacky to the touch. See col. 3, line 64 – col. 4, line 4. The aqueous carriers of instant claims 14-15, including water, ethanol and propanol are discussed in col. 7, lines 17 – 59. The solvents of instant claim 16, such as C10-C16 hydrocarbon, silicone derivatives, and ethers, isododecane being most preferred. See col. 6, line 28 – col. 7, line 25. As for instant claims 6 –8, examiner takes the position that, since Bolich discloses the composition having the same limitation of the instant claims, the undisclosed measurement of the tack or flexibility test value of the film formed by the composition and the average particle size of the copolymer, are characteristics that naturally flow from the prior art invention. While Bolich fails to explicitly mention that the composition form “hydrophobic” film, as recited in the amended instant claim 1, examiner views it obvious that the “film” formed from the hydrophobic linear copolymer is hydrophobic.

Response to Arguments

Applicant's arguments filed on February 19, 2002 have been fully considered but they are not persuasive in part.

Claim rejection in view of Bolich is maintained. Applicants argue Bolich does not anticipate the present invention, characterizing the prior art as a *solution* comprising a particular hydrophobic, volatile, branched hydrocarbon solvent. Examiner respectfully disagrees that the invention in Bolich is limited to a solution. Bolich teaches dispersion of copolymers throughout the carrier, which most preferably is water. See col. 7, lines 28 – 47. The hydrocarbon solvents disclosed in Bolich are also used in applicants' invention. Applicants' argument that they have found better film formation of the hydrocarbon solvents is persuasive since there is no evidence in the record supporting applicants' position, and the argument is not commensurate with the scope of the claims.

In addition, examiner notes that claim 9 fails to further limit claim 1, which is directed to a composition. Claim 9 recites a mere intended use of the composition in claim 1, which is not considered as a structural limitation.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951. The examiner can normally be reached on Monday-Friday, 8:30 am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
May 31, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200